

REMARKS

Applicant requests reconsideration and further examination of this application.

In the Detailed Action, the Examiner rejected Claims 15-16 under 35 U.S.C. § 102(b) as being anticipated by *Hirshberg*, United States Patent Number 6,742,635, and rejected Claims 1, 4-11, 13, and 17-18 under 35 U.S.C. § 103(a) as being unpatentable over *Hirshberg*, United States Patent Number 6,742,635, in view of *Scott*, United States Patent Number 5,099,530.

Applicant had amended Claim 1 to clarify that the upper half of the storage pouch “is a flap on the upper surface of the mat”. First, *Hirshberg*, United States Patent Number 6,742, 635, discloses a lower half of an interior compartment 50 that is not the upper surface of the mat (see interior surface 16 of interior compartment 50 vs. mat upper surface 45, in *Hirshberg*’s Figures 3 and 4). Indeed, *Hirshberg*’s lower half of interior compartment is underneath the mat’s bottom surface. Further, even if *Hirshberg*’s segregating means or “dividing wall” 52 (col. 3, line 30) and a portion of the sports bag exterior wall are considered to be an upper half of the interior compartment 50, the dividing wall 52 and exterior wall are not a flap and are not on the upper surface 45 of the mat. Further, the storage pouch and mat combination as claimed by Applicant in Claim 1 is not found in *Scott*.

Applicant contends that there is no suggestion to combine *Hirshberg* and *Scott*, and there is no suggestion or motivation to then further modify the combination to try to arrive at the invention claimed in Claim 1. Therefore, Applicant believes that there is no *prima facie* case of obviousness and the invention as claimed in amended Claim 1 is novel and unobvious in view of *Hirshberg* and *Scott*, either alone or in combination.

Regarding Claim 4, *Hirshberg* does not disclose or suggest a blanket attached to the storage pouch in addition to the mat. *Hirshberg* teaches a mat upon which “the user can lie down on the mat so that his/her head rests on the sports bag 10 which is used as a pillow and the upper portion of the user’s body rests on the upper surface 45 of the mat 40”(column 3, lines 44 - 47). Attaching a blanket to the interior compartment 50 of the *Hirshberg* sports bag would not make sense; such an attachment arrangement (with the blanket extending from the sports bag) would render the blanket ineffective and would cover or interfere with the user’s face or head as the user tries to put his/her head on the sports bag for use as a pillow. Further, *Scott*, United States

Patent Number 5,099,530, does not disclose or teach a blanket attached to a storage pouch such as defined in Applicant's Claim 1 (base claim for Claim 4), and even if combined with *Hirshberg*, *Scott* would only teach a blanket attached to the *Hirshberg* mat front edge 46, not the *Hirshberg* interior compartment 50. Further, there is no suggestion to combine the pad of *Scott* with the sport's bag of *Hirshberg*. Therefore, Applicant respectfully disagrees that it is obvious to attach a blanket to the storage pouch as claimed in Claim 4. Applicant believes that Claim 4 is novel and unobvious and allowable in its own right, as well as because it is dependent upon allowable Claim 1.

Applicant has amended Claim 6 to include a storage pouch fastener "adapted to fasten to said back surface of the mat, when the blanket is removed from the pouch fastener, to close the storage pouch". No new matter has been added, as this amendment is supported in the original specification on page 5 line 29 through page 6 line 2, for example. There is simply no blanket shown or suggested in either *Hirshberg* or *Scott* that attaches to a storage pouch fastener on the bottom surface of the upper half of a storage pouch, wherein the pouch fastener is adapted to close the pouch by fastening to the back surface of the mat. Therefore, Applicant believes that Claim 6 is novel and unobvious and allowable in its own right, as well as because it is dependent upon allowable Claim 1.

Applicant has amended Claim 7 to include a hook and loop connector system comprising "a pouch opening fastener on the upper half of the storage pouch that connects to a fastener on the back surface of the mat". No new matter has been added, as this amendment is supported in the original specification on page 5 line 29 through page 6 line 2, for example. Neither *Hirshberg* nor *Scott* teach a connector system for closing a storage pouch that comprises a pouch opening fastener on the upper half of the pouch that connects to a fastener on the back surface of the mat. *Hirshberg* teaches a zipper that closes the interior compartment 50 by connecting upper and lower portions of the sports bag wall together, with the mat 40 entirely inside. *Scott* teaches the pad/mat with cover folding in accordion-fashion along the transverse dashed lines shown in *Scott's* Figure 5, but does not teach any mat rolling up into a storage pouch and does not teach any pouch opening fastener fastening to the back of the mat. *Scott* teaches folding the longitudinal side edges 19 of a blanket "toward the center such that the folded width of the extended portion 18 is approximately the same as the width of the open end 15"(column 3 lines

65 - 68), but, again, no pouch closure and certainly no pouch opening fastener attaching to a fastener on the back of the mat. Therefore, Applicant believes Claim 7 is novel and unobvious and allowable in its own right, as well as because it is dependent upon allowable Claim 1.

Therefore, Applicant believes Claims 1, 4, 6, and 7 are allowable, and therefore Claims 5, 8-11 and 13 are also allowable in their own right or as being dependent upon an allowable independent Claim 1.

Applicant has also amended Claim 15, to clarify that the pouch comprises an upper flap extending over the upper surface of the mat and the upper flap has a fastener on an interior surface of the upper flap. Claim 15 recites that the upper flap fastener attaches to the fastener on the mat back surface to hold the mat within the pouch and to close the pouch opening. No new matter has been added, as support for these amendments exists in the original Description and Drawings, for example, at page 5, lines 24 through page 6, line 8, and Figures 2, 4 and 6. Applicant contends that the elements claimed in Claim 15 are not shown in either *Hirshberg* or *Scott*, as neither of these references includes any pouch closure that includes a fastener on an upper flap of the pouch attaching to a fastener on a back surface of a mat. Again, *Hirshberg's* compartment 50 closes by a zipper connecting portions of the sports bag exterior wall – not involving the mat. Again, *Scott* only teaches an accordion-fashion folding of a pad/mat and a blanket being folded longitudinally for insertion into a cover – not any pouch closures involving fastening of a pouch flap to the back of a mat. Further, Applicant contends that there is no suggestion to combine *Hirshberg* and *Scott*, and there is no suggestion or motivation to then further modify the combination to try to arrive at the invention claimed in Claim 15. Therefore, Applicant believes that the invention as claimed in amended Claim 15 is novel and unobvious in view of *Hirshberg* and *Scott*, either alone or in combination. Dependent Claims 16 - 18 are also allowable in their own right or as being dependent upon an allowable independent Claim 15.

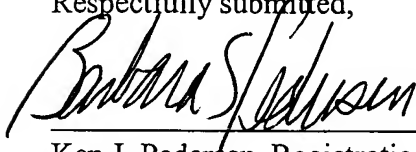
New Claim 19 (New) claims a sleeping pad consisting essentially of: a mat, a pillow at or near the top end of said mat, a storage pouch on the upper surface of the mat at or near said bottom end of said mat, and a blanket attached to said storage pouch, wherein the storage pouch comprises a lower half that is a portion of the upper surface of the mat and an upper half that is a flap extending over the upper surface of the mat, the flap having a bottom edge and two side edges that are connected to said mat, and a top edge that is the extremity of the pouch nearest the

top end of the mat, wherein said top edge is unattached from said mat to form an opening into the storage pouch that is adapted to receive the top end and central portion of the mat.

New Claim 19 uses the transitional phrase "consisting essentially of" (see closed language transitional phrases in MPEP 2111.03) and lists elements that do not include a sports bag as taught by *Hirshberg*. Clearly, the invention as claimed in Claim 19 is essentially a combination of a mat, pillow, storage pouch on the upper surface of the mat and a blanket, but does not include the cumbersome and substantial structure of a sports bag as taught by *Hirshberg*. The storage pouch as defined in Claim 19 certainly cannot be construed to be the same as the *Hirshberg* sports bag. In view of the transitional phrase, Applicant believes that neither the mat extending from the complex sports bag structure of *Hirshberg*, nor the mat of *Scott* having no storage pouch as defined by Claim 19, can be said to anticipate or make obvious the simple and effective mat/storage pouch/pillow combination claimed by Applicant in Claim 19. Applicant contends that there is no suggestion to combine *Hirshberg* and *Scott*, and there is no suggestion or motivation to then further modify the combination to try to arrive at the invention claimed in Claim 19.

Applicant now believes that the application, and Claims 1, 4 - 11, 13, and 15 - 19, are allowable, and respectfully requests the same.

Respectfully submitted,

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Ken J. Pedersen, Registration No. 29,689

Barbara S. Pedersen, Registration No. 36,237

P.O. Box 2666

Boise, ID 83701-2666

Telephone: 208-343-6355

Facsimile: 208-343-6341